

The opinion in support of the decision being entered today (1) was **not** written for publication in a law journal and (2) is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIM L. VAN'ORDER

Appeal No. 1998-0693
Application No. 08/387,583

ON BRIEF

Before THOMAS, HAIRSTON, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-36,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an electro-optic mirror with contrasting display. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. An electro-optic display comprising:

a pair of spaced transparent conductive layers having an electro-optic medium between said layers;

a first voltage source for applying a first electric field across said conductive layers for changing the light transmission characteristics of said medium;

a display defined by individual conductive display elements patterned on one of said conductive layers, each of said elements being surrounded by a non-conductive border; and

a display driver coupled to each of said display elements for selectively applying voltages to individual ones of said display elements of said one conductive layer to create an electric field between said elements and said other conductive layer different than said first electric field to provide a contrasting display.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Nicholson

4,184,751

Jan. 22, 1980

Admitted Prior Art at pages 1-2 of the specification (APA)

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Claims 1-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Appellant's Admitted Prior Art in view of Nicholson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 15, mailed Oct. 15, 1997), which incorporates the text of the rejection from a prior Office action (Paper No. 6, mailed Aug. 20, 1996) and the supplemental examiner's answer or letter clarifying the basis of the rejection (Paper No. 19, mailed Oct. 23, 2000) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 14, filed Sep. 11, 1997) and reply brief (Paper No. 16, filed Dec. 22, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that the objection to the drawings goes beyond the authority of the Board, therefore, we make no findings thereto. (See brief at page 5-7.)

35 U.S.C. § 103

We note that the examiner has expressly stated in the letter mailed Oct. 23, 2000 that the rejection is based solely upon the teachings of the APA in view of the Nicholson patent. Therefore, in our decision, we have not considered the teachings of O'Farrell, Yaguchi et al., Yaguchi or Hashimoto discussed and cited in the answer.

The examiner maintains that "the [claimed] invention is basically the admitted prior art (i.e., applying a contrasting display to a rearview mirror) with the additional concept of applying different electric fields across the segments of the display and the background area, and making the display variable." (answer, page 4). The examiner relies upon the teaching of Nicholson to teach the use of different potentials and for use of a variable display. We agree with the examiner that Nicholson teaches a variable display and use of different potentials, but the use of the different potentials is to select the variable colors of the background and the display segments (see Nicholson at columns 11-13.)

Appellant argues that the admitted prior art is "nothing more than the isolation of part of an electro-optic mirror behind which a conventional display is positioned." (See brief at page 7.) We agree with appellant that, from the discussion at pages 1-2 of the

specification, the display in the admitted prior art is not electrically interconnected to the electro-optical mirror operation. Appellant argues the O'Farrell reference, but we make no findings thereto, since it is not applied by the examiner in the rejection. (See brief at page 8.)

Appellant argues that Nicholson discloses merely an electro-optic display and does not teach or suggest a mirror in combination thereto. (See brief at page 8.) Appellant further argues that there is a lack of motivation to use a colored display in a mirror where accurate color reflections are expected. (See brief at pages 8-9.) We agree with appellant, but note that claim 1 recites an electro-optic display not a mirror. Therefore, this argument is not persuasive to claim 1 and the claims grouped therewith. We agree with appellant with respect to claims 11 and 32 and their respective groupings of claims as to the use in a mirror.

Appellant argues that "[u]nlike the Nicholson patent which teaches only conductive patterns defining display elements, claims 1 and 6 define an overall conductive layer on opposite sides of the electro-optic medium . . . claims 1 and 6 define a display which is defined by individual conductive display elements patterned on both [sic, at least one in claim 1] of the conductive layers and which are surrounded

by a non-conductive border.” (See brief at page 9.) Appellant further argues that
Nicholson

fails to disclose even overall first and second conductive layers but instead is limited to an electrochromic display with only display elements formed thereon. None of the prior art, including Nicholson, discloses an electro-optic display in which the entire display includes conductive surfaces to which a first voltage is applied and patterned display segments for creating a different electric field between the display elements and the electric field applied between the overall conductive layers by the first voltage. (See brief at page 10.)

We agree with appellant that, taking the claim as a whole, the examiner has not provided a teaching or convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to provide conductive segments in the layers of conductive material and “for selectively applying voltages to individual ones of said display elements of said one conductive layer to create an electric field between said elements and said other conductive layer different than said first electric field to provide a contrasting display” as recited in the language of claim 1.

The examiner postulates many modifications and variations to the APA and Nicholson while also discussing various other references, which are expressly not used in the rejection. (See prior Office action, Paper No. 6, at pages 4-5 and answer at page 4-6.) We disagree with the examiner’s conclusions and find that the examiner has not

provided a convincing line of reasoning for the proposed combination of a variable display into a rearview mirror where the variable display is formed of the same conductive layers which darken the mirror. Furthermore, with respect to claim 1, the examiner has not provided a teaching or a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to provide "a display defined by individual conductive display elements patterned on one of said conductive layers, each of said elements being surrounded by a non-conductive border." While Nicholson teaches a display with variable colors between the background and display segments, the examiner has not shown that the display segments and the background are formed in the same layer. We note that Nicholson discloses at column 6 that the character segments and background are simultaneously formed by deposition of a single continuous layer. Further, with the reversal of colors by switching the voltages and the fact that Nicholson is concerned with color matching between the segments and background, two portions would have to be similarly formed. Furthermore, the examiner has not addressed appellant's argument that Nicholson does not clearly teach the use of a pair of conductive layers or why it would have been obvious to one of ordinary skill in the art at the time of the invention to

incorporate a display formed integrally with a mirror rather than separate portions incorporated together as taught in the APA. While the examiner maintains that it would be obvious to associate a variable display with a mirror, (paper no. 6 at page 4), the examiner has not provided a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to form the two together on the same conductive layer. Appellant argues that Nicholson does not contemplate a contrasting display, but rather only a colored display. (See brief at page 10.) We agree with appellant.

The examiner maintains that appellant's arguments are not persuasive because the arguments are a combination of the APA and Nicholson and that "the Nicholson reference provides obvious motivation for modifying the admitted prior art electro-optic devices." (See answer at page 5.) We disagree with the examiner. Further, the examiner maintains at page 5 that appellant's argument that the skilled artisan would not be motivated to combine the color display of Nicholson with the mirror of the APA and that the color would be distracting, is not persuasive because it is merely appellant's opinion. The examiner further states the "nowhere does the rejection state that one skilled in the art would use Nicholson's teachings to add a color display to the

admitted prior art.” **Id.** Here, we disagree with the examiner’s picking and choosing of elements/features of the references at his discretion. Clearly, Nicholson teaches the use of multiple voltages to produce the available colors as discussed above. So, for the examiner to assert that the color would not be in the combination would tend to negate the examiner’s use of two voltages. Further, if the color were not to be used, then there would not be a need to have the segment and background conductor formed of the same layer since the color need not be matched as Nicholson suggests.

Here, we find that the examiner has not clearly addressed the language of the claims. We find that the examiner believes that the basic invention is obvious and attempts to buttress this belief with bits and pieces of prior art teachings combined together to reject the gist of the invention, yet never coming to grips with the language of the claims. This is impermissible. Further, this is clear from the prosecution of the case where the examiner originally rejects the claim over the APA in view of Nicholson and then discussed four other references throughout the prosecution, but never relying upon any of the other teachings. In a § 103(a) rejection, It is incumbent upon the examiner to make a ***prima facie*** case of obviousness. As discussed above, we find that the examiner has not made this ***prima facie*** case with respect to claim 1. Nor has

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the examiner made a ***prima facie*** case with respect to claims 6, 11, 17, 21, 27 and 32 which contain similar limitations but are more detailed than claim 1. Therefore, we cannot sustain the rejection of claims 1-36.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-36 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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